REMARKS

The Office Action has been received and carefully considered. The Office Action rejects claims 1-12 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,374,358 to Townsend ("Townsend") in view of U.S. Patent No. 6,895,382 to Srinivasan *et al* ("Srinivasan"). Applicants respectfully traverse these rejections. Reconsideration of claims 1-12 is respectfully requested based on the following remarks.

I.   The Office Action In General

Applicants request clarification regarding several paragraphs in the Office Action. Specifically, Applicants have been unable to understand the content of the following Office Action paragraphs:

- Last paragraph on page 2;

- Second full paragraph on page 5;

- Last paragraph on page 6; and

- Third full paragraph on page 8.

Should the Office maintain its rejection, Applicants request clarification regarding the above.

II.   The Cited References Fail To Disclose Migrating A Legacy Enterprise

Claim 1 recites "development of migration options in a legacy transaction enterprise" and "identifying potential components for the legacy enterprise." The remaining independent claims contain similar limitations. The cited references, alone or in combination, fail to disclose these features.

The Office Action concedes that "Townsend fails to explicitly teach providing by a computer migration options and developing by a computer the migration options." Applicants agree. The Office turns to Srinivasan as allegedly filling the hole left by Townsend. Applicants respectfully state that reliance on Srinivasan is misplaced.

Srinivasan is directed to overseas software development outsourcing. *See* Srinivasan, Abstract, column 1, lines 10-22 and claim 1. That is, Srinivasan is directed to migrating the *location* of software development. *Id.* In sharp contrast, the present claims are directed to migrating the *components* of a legacy transactional enterprise themselves. Simply stated, Srinivasan is directed to changing *where* software is developed, whereas the present claims are directed to changing *what* components of a legacy transaction enterprise should be migrated. Accordingly, Srinivasan is completely unrelated to the present invention as claimed.

To the extent that Srinivasan considers changing components, such consideration is limited to converting from one platform to another, *without any consideration given to options for the new platform*. Thus, Srinivasan discusses "Conversion," which is defined as "Where an existing application (or suite of applications) is to be migrated from one platform to another." *See* Srinivasan, column 8, lines 23-25. Importantly, Srinivasan's invention requires that a user define the exact components of the target environment. "[I]t is important to define accurately what the various components of the source and target environments will be." Srinivasan, column 15, lines 51-52. That is, Srinivasan does not discuss or consider developing options for replacing components of a legacy transaction enterprise. Instead, Srinivasan suffers from the problem solved by the present invention as claimed. Namely, a user of Srinivasan's invention is required

to develop, for him or herself, the specifications of a new platform. In sum, Srinivasan fails to disclose or suggest a computer-implemented method for structured development of migration options, as claimed.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: "[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations." Because neither Townsend nor Srinivasan disclose "development of migration options in a legacy transaction enterprise" or "identifying potential components for the legacy enterprise," Applicants respectfully request that the rejections of the claims be withdrawn.

III. Townsend Fails To Disclose Identifying And Developing Risk Factors For Potential Components For The Legacy Enterprise

Claim 1 recites "identifying potential components for the legacy enterprise" and "developing risk factors for the potential components of the legacy enterprise." The remaining independent claims contain similar limitations. The Office relies on Townsend as allegedly disclosing these features. As explained below, such reliance is misplaced.

Townsend fails to disclose identifying *potential* components for a legacy enterprise, as claimed. Townsend is concerned with "selecting a *security model* for an organization operating an application on the organization's computer network" rather than changing a legacy enterprise. *See* Townsend, Abstract (emphasis added). Townsend does not teach, suggest, consider or disclose adding components to a legacy enterprise. Consequently, Townsend cannot teach,

suggest, consider or disclose "identifying potential components for the legacy enterprise" as claimed.

At most, Townsend recites that a "Rule Base B" may include "rules for including or excluding various operating system services, such as authentication modules or I/O devices." *See* Townsend, column 4, lines 23-26. However, Townsend makes clear that such rules are applied to "modules or I/O devices" that *already exist* in organization's system, rather than to *potential* components as claimed. Indeed, Townsend refers to Rule Base B as being "for detecting exception conditions." "After these parameters [including Rule Base B] are determined for the business of the organization, *each application asset in the overall system* is evaluated independently [using, *inter alia*, Rule Base B at step 175]." *See* Townsend, column 4, lines 38-40 (emphasis added); *see also* Townsend, column 7, lines 33-37 and Fig. 1, item 175. Accordingly, Townsend at most considers evaluating pre-existing "modules or I/O devices." Townsend cannot and does not disclose or suggest identifying potential components.

Even assuming, without conceding, that Townsend discloses "identifying potential components," Townsend yet fails to disclose or suggest "developing risk factors for the potential components" as claimed. Nowhere does Townsend teach, suggest, consider or disclose developing risk factors for potential components. Indeed, it is impossible for Townsend to do so, as Townsend never considers identifying *potential* components, let alone "developing risk factors for the potential components." This limitation is completely absent from Townsend's disclosure.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: "[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations." Because Townsend fails to disclose "identifying potential components for the legacy enterprise" and "developing risk factors for the potential components of the legacy enterprise," Applicants respectfully request that the rejections of the claims be withdrawn.

IV. Townsend Fails To Disclose Identifying And Developing Risk Factors For Unmet Opportunities

Claim 1 recites "identifying unmet opportunities" and "developing risk factors for the unmet opportunities." The remaining independent claims contain similar limitations. The Office relies on Townsend as allegedly disclosing these features. As explained below, such reliance is misplaced.

Townsend fails to consider unmet opportunities at all, let alone risk factors for unmet opportunities. The Office Action fails to point to any disclosure in Townsend that meets these limitations. Applicants respectfully request, should the Office continue its rejection, that the Office point to the specific portion of Townsend that allegedly meets these limitations.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: "[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations." Because Townsend fails to disclose "identifying unmet opportunities" and

"developing risk factors for the unmet opportunities," Applicants respectfully request that the rejections of the claims be withdrawn.

V. Townsend Fails To Disclose Developing Migration Options Using Risk Factors For Components, Unmet Opportunities And Potential Components

Claim 1 recites "developing, by a computer, the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components." The remaining independent claims contain similar limitations. The Office relies on Townsend as allegedly disclosing these features. As explained below, such reliance is misplaced.

Townsend is directed to "selecting a security model" for an organization rather than developing migration options as claimed. Townsend neither discloses - nor has any need to disclose - developing migration options in a legacy enterprise, as Townsend's concerns lie elsewhere. Moreover, Townsend fails to teach, suggest, consider or disclose developing migration options using (1) risk factors for the components, (2) risk factors for the unmet opportunities, and (3) risk factors for the potential components. Indeed, as discussed above in Section IV, Townsend fails to offer any disclosure whatsoever of at least risk factors for the unmet opportunities.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: "[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations." Because Townsend fails to disclose "developing, by a computer, the migration options with associated risks using at least the risk factors for the components, the risk factors for

the unmet opportunities and the risk factors for the potential components," Applicants

respectfully request that the rejections of the claims be withdrawn.
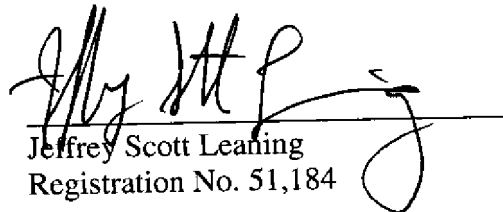
CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition

for allowance, and an early indication of the same is courteously solicited. The Examiner is

respectfully requested to contact the undersigned by telephone at the below listed telephone

number, in order to expedite resolution of any issues and to expedite passage of the present

application to issue, if any comments, questions, or suggestions arise in connection with the

present application.

Applicant believes that no fee is required for entry of the present Reply. Nevertheless, in the

event that a variant exists between the amount tendered and that determined by the U.S. Patent

and Trademark Office to enter this Reply or to maintain the present application pending, please

charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Dated: August 12, 2008   By:

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